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PATENT APPLICATION

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March 22, 2005

Vicki L. Gilbert

Vicki L. Gilbert

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark D. Braxton

Group Art Unit 2611

ON-DEMAND METHOD AND
SYSTEM FOR ENTERTAINING A USER

Examiner Joseph G. Ustaris

Serial No. 09/745,585

Filed December 21, 2000

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

**NOTICE OF APPEAL (REQUEST FOR REINSTATEMENT) AND
(SUPPLEMENTAL) APPEAL BRIEF FOR APPELLANT**

In response to the Office Action dated February 24, 2005, Applicants respectfully request reinstatement of the Appeal and are filing this Supplemental Appeal Brief to support the Appeal of claim 3, which was finally rejected in the Office Action dated February 24, 2005, and previously in the Office Action dated July 14, 2004. In the event a Notice of Appeal is required, this paper also serves as the required Notice. No fee is due because the Appeal fee was provided with the filing of September 13, 2004. If any fee is due, please charge the required fee to Deposit Account No. 07-0960.

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I. REAL PARTY IN INTEREST

In this appeal, the real party in interest is the assignee of record, Vauxhall Motors Limited, and additionally GM Global Technology Operations, Inc., both wholly owned subsidiaries of General Motors Corporation.

II. RELATED APPEALS AND INTERFERENCES

This is a reinstatement of the Appeal filed September 13, 2004; there are no prior Board decisions.

III. STATUS OF CLAIMS

Claim 3 is finally rejected and is on appeal.

Claims 1, 2 and 4-13 are cancelled by amendment dated May 12, 2004.

IV. STATUS OF AMENDMENTS

Vauxhall Motors has filed no amendments since the Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 3 recites an on-demand method using an entertainment device that can provide entertainment to a user while also, as a background function not apparent to the user, monitoring and storing selected movies from remotely broadcast movie data. The method comprises the steps of: providing a conventional entertainment to the user (page 6, line 20 – page 7, line 4; fig. 3, references 64 and 66); monitoring a remote broadcast of for-demand movie data (page 7, lines 8-14; fig. 4, reference 82); receiving the for-demand movie data (page 7, lines 15-16; fig. 4, reference 84); storing the received for-demand movie data (page 7, lines 16-18; fig. 4, reference 86); providing the operator with a selection of choices

corresponding to stored for-demand movie data (page 7, lines 18-22; fig. 4, reference 88); receiving a user input designating an entertainment choice representing one of the choices corresponding to stored for-demand movie data (page 7, lines 22-23; fig. 4, reference 90); using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user (page 7, lines 23-24; fig. 4, reference 92).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claim 3 stands rejected now under 35 U.S.C. 102 (e) as being anticipated by Russo (US6025868).

VII. ARGUMENT

Russo discloses a system for stored program pay-per-play. The system has “automatic recording of one or more selections based ... upon viewer preferences ... for subsequent replay,”¹ which can be pay-per-view.² Russo does not disclose a system that can monitor and store remote broadcasts of movie data as a background function not apparent to the user. Instead Russo teaches away from monitoring broadcasts by teaching the use of schedule information to “enable unattended recording of a desired program.”³ Further, Russo provides no suggestion that any monitoring or unattended recording is a background function not apparent to the user. Thus Russo cannot anticipate Applicants’ claim 3.

Vauxhall Motors begins this Argument at the point from which all obviousness determinations must be made.

¹ Col. 9, line 66 – col. 10, line 3.

² Abstract.

³ Col. 9, lines 60-61.

A. THE SCOPE AND CONTENT OF THE PRIOR ART: RUSSO

Russo discloses a system for stored program pay-per-play. The system has “automatic recording of one or more selections based ... upon viewer preferences ... for subsequent replay”⁴ which can be pay-per-view.⁵ Russo teaches to use “[f]uture schedule information”⁶ for use in a “future record memory 156.”⁷ The “future record memory 156” is utilized to store the schedule of programs to “enable the automatic and unattended recording of a desired program.”⁸ Russo allows scheduling for both exact selections and also for scheduling selections based upon viewer preferences. To make this clear, Russo expressly refers to U.S. Patent 4,908,713, entitled “VCR Programmer.” Russo makes no suggestion to do away with its future record memory 156 and instead monitor broadcasts for the desired movie data. Neither the text nor the figures discuss or illustrate a broadcast monitoring function for desired movie data. Further, there is no teaching that any monitoring or the “automatic and unattended recording” is done as a background function.

B. THE INVENTION OVER RUSSO

Claim 3 requires (i) *providing a conventional entertainment to the user*, (ii) *monitoring a remote broadcast of for-demand movie data ...* (iii) *storing the received for-demand movie data; ...and (iv) using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user*. Russo fails to teach monitoring a remote broadcast of for-demand movie data that can be recorded for playback that is carried out as a background function not apparent to the user.

⁴ Col. 9, line 66 – col. 10, line 3.

⁵ Abstract.

⁶ Col. 9, line 48.

⁷ Col. 9, lines 58-59; figure 2.

⁸ Col. 9, lines 60-61.

While Russo allows recording whether or not the user is present, it does not teach either *monitoring a remote broadcast of for-demand movie data* or recording movies as *a background function not apparent to the user*. Quite to the contrary, Russo expressly teaches away from the invention of claim 3 by disclosing automatic recording that does not involve monitoring broadcasts as a background function and instead using future schedule memory information.

In the first section cited by Examiner below,⁹ Russo refers only to receiving supplemental information provided either with the program, on an unused channel, or available through dialing out.

Several types of supplemental information are possible, including **future schedule memory information**... It should also be noted that, while in the preferred embodiment such supplemental information may be derived from the program provider along path 102, either in an unused portion of one or more channels or through the use of an unused channel in its entirety ... In the case of the telecommunications subsystem it is implied that block 140 includes dialing capabilities ... enabling the system to automatically dial out a predetermined number and receive such supplemental information through an automatic process without requiring assistance.¹⁰

There is no mention of the required background monitoring. In fact this portion teaches away from background monitoring by downloading future schedule memory information as supplemental information. Since Russo has the future schedule memory information, it has no need to **monitor** for movies because recording times are **scheduled**.

Second, in col. 9, line 48 – col. 10, line 20, Russo expressly teaches using the “**future schedule information**” to allow the “operator to peruse a currently available or upcoming

⁹ Citation to Col. 8, line 64 – col. 9, line 20.

¹⁰ Col. 8, line 65 – col. 9, line 20.

selections”¹¹ and “enable the automatic and unattended recording of a desired program.”¹² This confirms that Russo expressly teaches away from the invention because a scheduled recording has no need for monitoring broadcasts as are required by the claimed invention. Russo teaches this scheduling for both specific selections and also for scheduling selections based “upon viewer preferences from which a desired program might be implied.”¹³

As Russo explains, and illustrates in Figure 2, the Future Record Memory 156 is utilized to store the schedule of programs to “enable the automatic and unattended recording of a desired program.” To make this clear, Russo expressly refers to U.S. Patent 4,908,713, entitled “VCR Programmer,” as follows:

U.S. Pat. No. 4,908,713, for example, discloses hardware and methods which may be used in conjunction with this invention for the purposes of selecting such information for transfer to a future record memory 156 which, in conjunction with real-time clock 157 will enable the automatic and unattended recording of the desired program.¹⁴

Russo makes no suggestion to do away with its “future record memory 156” and instead monitor broadcasts for the desired movie data. Further, there is no teaching that the “automatic and unattended recording” is done as a background function.

The law of anticipation is clear, “anticipation under [Section] 102 can be found only if a reference discloses exactly what is claimed.”¹⁵ “[A]bsence from the reference of *any* claimed element negates anticipation” of the claim by the reference.¹⁶ Further a “reference ... must have been considered for all it taught, disclosures that diverged and taught away from the

¹¹ Col. 9, lines 54-55.

¹² Col. 9, lines 60-61.

¹³ Col. 10, lines 1-2.

¹⁴ Col. 9, lines 55-60.

¹⁵ *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773 (Fed.Cir. 1985).

¹⁶ *Kloster Speedsteel v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81 (Fed.Cir. 1986), *cert. denied* 479 U.S. 1034, 107 S.Ct. 882, *modified* 231 U.S.P.Q. 160, (*emphasis added*).

invention at hand as well as disclosures that pointed towards and taught the invention at hand."¹⁷

Because Russo fails to teach the monitoring of the broadcasts, but instead uses scheduled recording, and because Russo fails to teach unattended recording as a background function, Russo fails to anticipate claim 3.¹⁸ Further, because Russo teaches away from monitoring the broadcast by instead using scheduling information, it fails to suggest claim 3.¹⁹

SUMMARY

Russo discloses a system for stored program pay-per-play. The system has automatic recording of one or more selections based upon viewer preferences for subsequent replay. But Russo does not disclose a system that can monitor and store remote broadcasts of movie data as a background function not apparent to the user. Instead Russo teaches away from monitoring broadcasts by teaching the use of schedule information to enable unattended recording of a desired program. Further, Russo provides no suggestion that any monitoring or unattended recording is a background function not apparent to the user. Thus Russo cannot anticipate Applicants' claim 3 because it does not disclose the combined requirements of: (i) *providing a conventional entertainment to the user*, (ii) *monitoring a remote broadcast of for-demand movie data ...*(iii) *storing the received for-demand movie data; ...and* (iv) *using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user.*

¹⁷ *Ashland Oil v. Delta Resins & Refractories*, 776 F.2d 281, 227 U.S.P.Q. 657, 665, n. 17 (Fed. Cir. 1985), *cert. denied* 484 U.S. 1017, 108 S.Ct. 725, *cert. denied* 475 U.S. 1017, 106 S.Ct. 1201.

¹⁸ *Kloster Speedsteel*, *supra*.

¹⁹ *Ashland Oil*, *supra*.

For the foregoing reasons, Vauxhall Motors respectfully requests the Board to **REVERSE** the final rejection of claim 3.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony Luke Simon', is written over a horizontal line.

Anthony Luke Simon, Attorney
Registration No. 34434
(313) 665-4714

CLAIMS APPENDIX

3. An on-demand method of entertaining a user using an entertainment device comprising the steps of:

- providing a conventional entertainment to the user;
- monitoring a remote broadcast of for-demand movie data;
- receiving the for-demand movie data;
- storing the received for-demand movie data;
- providing the operator with a selection of choices corresponding to stored for-demand movie data;
- receiving a user input designating an entertainment choice representing one of the choices corresponding to stored for-demand movie data;
- using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user.